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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,916	10/11/2001	Abbas Lamouri	ADV08 005	7461

7590
Duane Morris LLP
Suite 700
1667 K Street, NW
Washington, DC 20006

08/27/2003

EXAMINER

RAMSEY, KENNETH J

ART UNIT	PAPER NUMBER
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2879

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,916

Applicant(s)

LAMOURI, ABBAS

Examiner

Kenneth J. Ramsey

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Non-Statutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 22-25 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Application Serial Number 09/800669, to issue as Patent 6,612,892 on September 2, in view of Cap et al (4,161,672). Although the claims are not identical to claim 3, they are not patentably distinct because they are other than the fact that the arc tube of the patent claim may or may not be enclosed within a second bulb, such that the sealing of the arc tube is not the sealing of the outer bulb, the claims are broader than claim 3 of the copending application. Moreover, as shown by Cap et al, column 6, lines 8-21, a second "outer bulb" is an optional member of an arc lamp since it is possible for the arc bulb itself if made thick enough to withstand the high pressure of the lamp. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's

Art Unit: 2879

invention to perform the process of the patent claim in the case wherein the arc lamp body comprises the outer bulb.

2. Claim 26 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 50 of U.S.

Application Serial no. 09/800,669. Although the claim is not identical to claim 50, it is not patentably distinct because other than the fact that the arc tube of the patent claim may or may not be enclosed within a second bulb, such that the sealing of the arc tube is not the sealing of the outer bulb, it is broader than claim 50 of the copending application. Moreover, as shown by Cap et al, column 6, lines 8-21, a second "outer bulb" is an optional member of an arc lamp since it is possible for the arc bulb itself if made thick enough to withstand the high pressure of the lamp. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to perform the process of the patent claim in the case wherein the arc lamp body comprises the outer bulb.

Prior Art Rejections

1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Hansler et al (US-4,389,201). Hansler et al, figure 20, teaches the step of cooling the bulb and gas fill while sealing the bulb so that the pressure of the bulb will be other than atmospheric

Art Unit: 2879

pressure when the bulb is at room temperature. At the time of sealing the arc lamp, the arc lamp tube is the outer bulb. The fact that the arc tube may or may not be later enclosed within still a second outer bulb does not impart patentability to an old process.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansler in view of Cap et al (4,161,672). Hansler differs at most from claim 22 in that the arc tube of Hansler may or may not comprise the outer bulb of a finished arc lamp. However, as shown by Cap et al, column 6, lines 8-21, there are cases wherein the arc lamp tube made by the process of Hansler would comprise the outer bulb of the arc lamp. Contrary to applicant's arguments, it is entirely reasonable for one to have a thick wall arc tube capable of being the outer bulb as indicated by the reference to Cap et al. For a thin wall arc tube, the outer bulb (at the operating temperature) would contain a gas at higher than atmospheric pressure but not as great as that within the arc tube, so that the pressure differential is less than would be the case if there were no outer bulb so that the pressure differential is not capable of breaking the arc tube. However, there are clearly instances wherein the arc tube it self may obviously comprise the outer bulb, such as a thick wall bulb or a bulb designed for use in a high-pressure chamber, e.g. for deep sea robots. Thus the recited process as claimed is obvious.

Allowable Subject Matter

- 2) Claims 1-21 are allowed. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim for the reasons indicated in the last Office action. Claims 17-20 are deemed allowable since the prior art does not suggest the application of the fill process of the prior application to single ended lamps having a stem. The remaining claims are deemed allowable for the reasons stated in the last Office action.

Response to applicants' arguments

- 3) Applicant argues that the arc lamp of the patented invention of the copending application and the arc lamp of the Hansler reference do not comprise the outer bulb of the arc lamp. While this may be true in most cases, for the reasons set forth in the current action, that fact does not impart patentability to the claimed process, since as shown by Cap et al, the arc tube itself may have sufficient thickness (or strength) to comprise the outer bulb. Although applicant has referenced the disclosure of two embodiments in the specification for a definition of the term "outer envelope", those embodiments are disclosed to be not exclusive (see page 8, last paragraph of the specification). Thus the term "outer envelope" has no special meaning defined in the specification. It is the examiners, position that an arc tube having no outer envelope is also an outer envelope as per the ordinary meaning of the term. Moreover, as to the obviousness double patenting rejection, it would have

Art Unit: 2879

been clearly obvious to one of ordinary skill, that the process of the prior application has utility wherein the bulb comprises the outer bulb of a lamp.

Conclusion

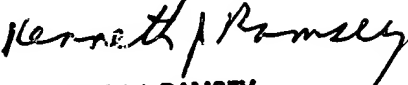
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Directions for Responses

Any formal response to this communication should be directed to examiner Kenneth J. Ramsey, (703) 308-2324 .

kjr
August 19, 2003


KENNETH J. RAMSEY
PRIMARY EXAMINER